

Claims 9, 11, 13, 14, 16 and 18 are pending in the present application. All of the claims stand rejected under 35 U.S.C. Section 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention. It is further stated that Applicants do not teach "consisting essentially of" and specifically do not teach what is excluded and/or included by this language or what does and does not materially affect the invention. The rejection is hereby traversed and reconsideration is respectfully requested.

The term "consisting essentially of" is an art recognized term which includes the stated ingredients but does not exclude the addition of other ingredients which do not materially affect the characteristics of the invention. Lauder Technologies Corp. v. Calco, Ltd., 7 U.S.P.Q. 2d 1097 (Fed. Cir. 1998), Cert. Denied, 488 U.S. 968 (1988).

Because the term "consisting essentially of" is well defined and its meaning is clear, a definition of this term on what it specifically encompasses is not required. Any additional ingredient which does not materially effect the characteristics of the invention is included, all others are excluded.

The question is then, what would materially effect the characteristics of the invention?

The present invention is directed to enhanced flavoring compositions and confectionery compositions and chewing gums containing the same. The top paragraph of page 2 of the present application indicates that enhancing the impact of fruit flavors has attracted a great deal of attention and that there is a desire to enhance fruit flavors utilizing various additives such as the use of citric acid in peppermint to accentuate the peppermint flavor (page 2, second paragraph).

The discovery of the present invention is the use of a known cooling agent, not to provide a cooling effect, but to enhance a flavor, especially fruit flavors. As indicated at the bottom of page 3, a synergistic effect has been found when the carboxamide is used at low levels in combination with the flavoring agent. The character of the flavor is generally found to be sharper or brighter, punctuated, and longer-lasting over conventional flavors (page 4, lines 1-4).

Of particular importance to the issues herein is the paragraph bridging pages 2 and 3 of the present application which makes it clear that cooling agents have a negative impact on flavors, particularly fruit flavors. Therefore it would be unexpected for the carboxamide which is a cooling agent to enhance the taste of flavors without negatively impacting on the flavors.

Menthol which is the best known cooling agent but one with well known drawbacks such as high volatility, bitterness and a strong minty flavor, would

therefore not be chosen as a "flavor" in the present invention because a) the prior art teaches the combination of the carboxamide and menthol (column 2, last four lines) and b) menthol has a negative impact on flavors as does other compounds which behave in the same way (i.e. cooling compounds).

No one can argue that menthol and related compounds are flavors. However, in the context of the present invention those additional compounds which are cooling agents (e.g. menthol) are excluded from the present claims because of their negative impact on flavors.

Eucalyptus like menthol is a flavor. Applicants have previously explained that eucalyptus contains cineole which like menthol is an aromatic compound which gives additional nasal impact. Eucalyptus oil, like peppermint oil (which contains menthol) is an essential oil that provides an independent cooling effect. Thus, while eucalyptus was listed among many different flavors in the specification, Applicants have limited the claimed invention to only those flavors which in addition to not containing menthol do not behave like menthol (i.e. have no cooling effect). As indicated above, the specification clearly supports the limitation of flavors to only those which do not contain menthol and do not contain any other ingredient which exhibits a cooling effect like menthol. This is the reason why the exclusion of eucalyptus from the flavors which are now set forth in the present claims is proper and supported in the application as filed.

Contrary to the statements made in the Office Action, there is a clear basis in the specification for limiting claims to exclude eucalyptus. Furthermore, the written description requirement of 35 U.S.C. Section 112 mandates that Applicant:

“recount his invention in such detail that his future claims can be determined to be encompassed within his original creation” [Vas Cath Inc. v. Mahurkar, 19 U.S.P.Q. 2d 111, 115 (Fed. Cir. 1991)]. The flavors now set forth in the claims are encompassed with the original disclosure of the invention.

Furthermore, there is nothing in MPEP 706.03 (o) which indicates that the deletion of a single item from a Markus group necessarily results in new matter. Applicants have provided a rational basis for the elimination of a single flavoring agent and have shown reasons why elimination of this flavoring agent is consistent with the overall teaching of the present application. It is therefore submitted that the rejection of the present claims under 35 U.S.C. Section 112, first paragraph is improper and should be withdrawn.

All of the claims of the application stand rejected as obvious over Cherukuri (U.S. Patent No. 5,009,893). The rejection is hereby traversed and reconsideration is respectfully requested.

Applicants have previously discussed the Cherukuri reference in detail and have emphasized that the teaching of the reference is the combination of the

carboxamide cooling agent and menthol and that they must be used together. Conversely, the absence of the combination is a teaching away from the fair disclosure of the reference. With respect to Table 5 and particularly Sample 3, Cherukuri shows a comparative confectionery composition containing cherry flavor and a cooling compound (eucalyptus) absent menthol. Sample 3 contains eucalyptus oil which as discussed above contains cineole similar in effect to menthol and therefore lies outside of the scope of the present claims. As previously indicated, it is only the cooling agent carboxamide which is used to enhance the specific flavors provided in the claims. The language "consisting essentially of" limits the present claims to the stated ingredients and those ingredients which do not materially affect the characteristics of the invention and thereby excludes menthol and those compounds which behave like menthol such as eucalyptus (i.e. cineole).

Claims 14 and 18 stand rejected over Record (U.S. Patent No. 5,372,824). The Office Action states that Record discloses the combination of flavor and the carboxamide in amounts claimed for use in chewing gums. The Office Action further states that the claims differ as to enhancement and the specific flavors. The conclusion reached in the Office Action is that it would have been obvious to a person of ordinary skill in the art to use any flavor in Record because the choice of flavor is deemed to be no more than a matter of choice within the skill of the art. This statement is clearly incorrect and ignores the essential features of the claimed invention.

The claimed invention requires the presence of carboxamide and a select group of flavoring agents which are enhanced or potentiated by the presence of the carboxamide. These flavoring agents cannot include menthol or other compounds which have a cooling effect like menthol (e.g. cineole). Record does not provide this teaching or suggestion. There is nothing in Record to suggest that the carboxamide can potentiate the flavors of the select group set forth in the present claims. To the contrary, Record teaches the presence of menthol which as explained in the context of the Cherukuri reference differs significantly from the present invention.

This is not a matter of just choosing any flavor but discovering that the carboxamide would enhance a select group of flavors when it is known that other cooling agents (menthol and compounds having a similar effect to menthol) would have a negative impact on flavors. This discovery is unexpected because the carboxamide is a known cooling agent like menthol.

It is therefore submitted that the rejection of claims 14 and 18 based on Record is improper and should be withdrawn.

In view of the foregoing, Applicants submit that the present application is in condition for allowance and such action is respectfully requested. Applicants acknowledge as indicated at the top of page 2 of the Office Action, that claims 12 and 17 were previously canceled.

ARK:jsg022007/1901041.RES-3

It is believed that no fee is due in connection with this matter. However, if any fee is due, it should be charged to Deposit Account No. 23-0510.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Allen R. Kipnes", written over the typed name and registration information.

Allen R. Kipnes, Esquire
Registration No. 28,433
Attorney for Applicant

Address All Correspondence to:

Allen R. Kipnes, Esquire
WATOV & KIPNES, P.C.
P.O. Box 247
Princeton Junction, NJ 08550
(609) 243-0330